UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr>
<td rowspan="2" colspan="2">Office Action Summary</td>
<td>Application No.
09/872,116</td>
<td>Applicant(s)
CHERRY ET AL.</td>
</tr>
<tr>
<td>Examin r
James H Blackwell</td>
<td>Art Unit
2176</td>
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</table>

-- Th MAILING DATE of this communicati n appears on th cov r sh et with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 September 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3 and 7-23</u> is/are pending in the application.

    4a) Of the above claim(s) <u>2 and 4-6</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 7-23</u> is/are rejected.

7)☒ Claim(s) <u>3</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>01 June 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This Office Action is in response to Amendment, received 09/20/04.

Claim Objections

Claim 3 objected to because of the following informalities: Claim 3 depends on

Claim 2, which was cancelled by applicant in their amendment. For purposes of

examination, Examiner assumes Claim 3 is dependent upon Claim 1 as amended Claim

1 incorporates content previously found in Claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith (U.S.

Patent No. 5,860,362).

In regard to independent Claim 10, <u>Smith</u> teaches a system which comprises a

self-service newspaper vending machine (2) includes an electronic control means (34)

with an on-line connection (36) to a news providing organization (38) from which a

newspaper containing up to the minute news can be purchased. A customer is attracted

by news stories shown on a display (6) (*providing the user a menu of available media*

selections for choosing a desired media selection for creation). The customer is then

given the opportunity of purchasing a newspaper or part of a newspaper (*identifying a*

media selection made by the user). Communication between the customer and the

vending machine (2) is by the display (6) and a keyboard (8). The newspaper can be

purchased by either inserting a banking or credit card in a card reader (52) or inserting

coins into a coin slot (50). The vending machine (2) would then *print out* the up to the

minute news requested (see Abstract; compare with Claim 10, *"... retrieving a data*

format copy of said media selection; and printing a hardcopy of said media

selection from said data format copy of said media selection").

In regard to dependent Claim 12, Claim 12 reflects the method of creating a

hardcopy media selection for a user as claimed in Claim 10, and is rejected along the

same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 9, 11, 13-15, and 17-19 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Smith in view of Leeke et al. (hereinafter Leeke, U.S. Patent

No. 6,587,127).

In regard to independent Claim 1, Smith teaches in Fig. 2, an electronic controller

(34) is used to run the vending machine (*A personalized media service device for*

producing media on demand). In order for the vending machine to print out up to the

minute information, the electronic controller (34) has an on-line connection (36) to a

news providing organization (38). The on-line connection (36) may use the Public

Switched Telephone Network (PSTN) with there being a modem (not shown) to provide

the interface between the PSTN and the controller (34). The controller (34) contains a

PC processor (40) to provide the control, a ROM (42) and a RAM (44) for storing the

information received from the news providing organization (38). The PC processor (40)

communicates with the keyboard (8) and a checking mechanism (not shown)

associated with the payment slots (10) via a self-service Input/Output (I/O) system (54).

The processor (40) communicates with the display (6) via a display subsystem (56).

Also, the processor (40) communicates with the paper sensor (30), the printer (12), the

bunching mechanism (22), the feeders (18a, 18b) and a loudspeaker (48) and receives

on-line information from the news providing organization (38) via a PC I/O System (58)

(Col. 2, lines 43-63; compare with Claim 1, *"... a media selection interface for*

receiving a media request from a user and printing a hardcopy of said media

request, said media selection interface ..."). Smith also teaches that the controller

(34) contains a PC processor (40) to provide the control, a ROM (42) and a RAM (44)

for storing the information received from the news providing organization (38) (Col. 2,

lines 51-54; compare with Claim 1, *"... a memory for storing media data"*). Smith

also teaches a printer (12) that prints the whole newspaper or the part of the newspaper

requested. The printed sheet or sheets are taken by a feeder (18b) (Fig. 2) to an

opening (20) in the housing (4) for collection by the customer (Col. 2, lines 24-28;

compare with Claim 1, *"... a printer device for printing said hardcopy of said media*

request"). Smith also teaches that the controller (34) sends instructions to be displayed

on the display (6). The loudspeaker (48) can be used to give verbal instruction in

conjunction with the displayed instructions. The customer communicates his response

back via a keyboard (8) (*an input device for retrieving information from a user*). The

customer indicates what news he wants and the controller (34) displays on the display

(6) the cost (*a display device for displaying lists of available media selections and input*

options). The customer makes his payment via the payment slots (10) (Col. 3, lines 6-

13). Smith also teaches that the electronic controller (34) has an on-line connection (36)

to a news providing organization (38). The on-line connection (36) may use the Public

Switched Telephone Network (PSTN) with there being a modem (not shown) to provide

the interface between the PSTN and the controller (34) (*at least one communications port for communicating with a remote device*) (Col. 2, lines 45-49). Smith also teaches that the controller (34) contains a PC processor (40) to provide the control (*a central processing unit for communicating with said memory, said printer device, said input device, said display device, and said at least one communications port*) (Col. 2, lines 51-52). Smith also teaches that the electronic controller (34) has an on-line connection (36) to a news providing organization (38) (*service provider, providing media in a data format to said media selection device*). The on-line connection (36) may use the Public Switched Telephone Network (PSTN) with there being a modem (not shown) to provide the interface between the PSTN and the controller (34) (Col. 2, lines 45-49). Smith does not teach the specifics of the *service provider*. However, Leeke teaches, in Fig. 1, a block diagram of an embodiment of a system for providing audio content via an electronic network (100). Preferably, the electronic network (100) includes the Internet, the World Wide Web, an intranet, an extranet, or an on-line service such as America Online or WebTV. The system comprises a server (102), which communicates with a plurality of client apparatus (104) including a client apparatus (106) via the electronic network (100). The server (102) includes a computer (110) having a processor (112), a memory (114), and a storage device (116). The server (102) has a transceiver (120) such as a modem, a network adapter, or a wireless transceiver, which interfaces with the electronic network (100) (Col. 4, lines 8-20; compare with Claim 1, *"... a computer for communicating with said central processing unit"*). Leeke also teaches a customer profile component (150) (on the server) stores and manages a table

(database) of end user data. The end user data includes a record comprising one or

more of a name, an address, a login, an electronic mail address, *preferences* (user),

and demographics for each end user.(Col. 6, lines 3-15; compare with Claim 1, *"... at*

least one user profile database for storing demographic information about users

of said personalized media service received from said central processing unit").

Leeke also teaches that based upon any of the user-generated rating information and

comments described herein, the music testing component (152) in Fig. 1 generates and

provides reports including the actual data and/or summaries thereof. Each report can be

specific to one or more songs associated with an entity such as a record company. The

report is communicated to the entity to provide rating information and comments for its

music items. The report can be stratified by demographics such as *gender, age,*

occupation, and geographical region of the end users (Col. 38, lines 27-36; compare

with Claim 1, *"...said stored demographic information about a user in said user*

profile database comprising information selected from the group consisting of

gender, age, hobbies, interests, income, profession, education, marital status,

vehicles owned, sports played, consumer goods owned, services used, and user

preferences"). Leeke also teaches that a content delivery component (141), including

a player (142), resides on the server (102) to assist in selecting, retrieving, and playing

the audio content. The player (142) includes a computer program or other form of

software or firmware, which directs the server (102) and the client apparatus (106) to

provide a graphical user interface for selecting, retrieving, and playing back audio

content. More particularly, the computer program is operative to process and respond to

user-initiated events, actions, and selections made using the at least one input device

(124), to select, retrieve, and playback the audio content using the audio output device

(136). Preferably, the computer program includes one or more of Hyper Text Marking

Language (HTML) code, an applet (e.g. a JAVA applet), and animation plug-in code

(e.g. Shockwave code) to provide the graphical user interface. The player (142) is

accessible via the electronic network (100) by a dedicated electronic address such as a

URL (Uniform Resource Locator). The player (142) accesses audio content either

locally from the server (102) or remotely from a server (144), and communicates the

audio content to the client apparatus (106) using streaming technology. The server

(144) can include, for example, a server from which AudioNet content is accessible

(Col. 4, lines 50-67; compare with Claim 1, *"... at least one database of available*

media selections and corresponding media selection retrieval information for

providing media in said data format to said central processing unit"). It would

have been obvious to one of ordinary skill in the art at the time of invention to combine

the teachings of Smith and Leeke, because both inventions deal with online services

providing customized information based on user input. The teaching of Leeke adds the

benefit of storing user information including demographics allowing for a customer to

retrieve only the information they want, or what is deemed most interesting or useful to

them.

In regard to dependent Claim 3, Smith teaches a ROM (42) and a RAM (44) for

storing the information received from the news providing organization (38) (Col. 2, lines

51-54; compare with Claim 3, *"... media stored in a data format in said memory for retrieval by said central processing unit and printing by said printer device"*).

In regard to dependent Claim 9, <u>Smith</u> teaches that a card inserted into the card reader (52) may be of a type similar to a phone card which is purchased elsewhere and has a fixed number of units, initially stored on it. As purchases are made, the units stored on the card are reduced. If the card is of a type that needs connection to a banking system, this can be done via a modem connected to the PSTN. Connection to the PSTN allows access to the Internet. The self-service vending machine (2) can have the facility for credit card transactions to be transacted over the Internet (Col. 3, lines 23-32). Hence, transactions with the card would necessarily be authenticated before actions took place. Compare with Claim 9, *"... an authentication device for communicating with said central processing unit for identifying a user of said personalized media service"*).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Leeke.

In regard to dependent Claim 11, <u>Smith</u> does not specifically teach *a user interface with a touch screen display*. However, <u>Leeke</u> teaches an input device (124) that can include a keyboard, a pointing device, and/or a touch screen for receiving user-initiated events, actions, and selections from an end user (Col. 4, lines 37-40). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of <u>Smith</u> and <u>Leeke</u> as both inventions deal with generating selected

content initiated trough a user interface. Leeke provides the benefit of incorporating a

keyboard into a touch screen that can also simultaneously display content selections.

In regard to dependent Claim 13, Smith does not explicitly teach *establishing a*

connection between a computer and a service provider using the Internet. However,

Leeke teaches in Fig. 1 a block diagram of an embodiment of a system for providing

audio content via an electronic network (100). Preferably, the electronic network (100)

includes the Internet, the World Wide Web, an intranet, an extranet, or an on-line

service such as America Online or WebTV (Col. 4, lines 7-12). Leeke also teaches a

content delivery component (141), including a player (142), resides on the server (102)

to assist in selecting, retrieving, and playing the audio content. The player (142)

includes a computer program or other form of software or firmware, which directs the

server (102) and the client apparatus (106) to provide a graphical user interface for

selecting, retrieving, and playing back audio content (*linking said computer to a menu*

page stored in a memory of said service provider). More particularly, the computer

program is operative to process and respond to user-initiated events, actions, and

selections made using the at least one input device (124) (*displaying said list of*

available media selections on said menu page linked to said computer; and prompting

said user to choose one of said available media selections), to select, retrieve, and

playback the audio content using the audio output device (136). Preferably, the

computer program includes one or more of Hyper Text Marking Language (HTML)

code, an applet (e.g. a JAVA applet), and animation plug-in code (e.g. Shockwave

code) to provide the graphical user interface (*retrieving a list of available media*

selections from said memory of said service provider). The player (142) is accessible

via the electronic network (100) by a dedicated electronic address such as a URL

(Uniform Resource Locator) (Col. 4, lines 50-67). It would have been obvious to one of

ordinary skill in the art at the time of invention to combine the teachings of Smith and

Leeke as both inventions deal with generating selected content initiated trough a user

interface. Leeke provides the benefit of a detailed and versatile graphical user interface

and program to facilitate interaction with the electronic content.

In regard to independent Claim 14, Claim 14 reflects the method of creating a

hardcopy media selection for a user as claimed in Claim 1 and is rejected along the

same rationale.

In regard to dependent Claim 15, Smith teaches a printer (12) that prints the

whole newspaper or the part of the newspaper requested. The printed sheet or sheets

are taken by a feeder (18b) (Fig. 2) to an opening (20) in the housing (4) for collection

by the customer (Col. 2, lines 24-28; compare with Claim 15, *"... printing a hardcopy*

of said electronic copy of media associated with said media request on said

printer device of said media selection interface").

In regard to dependent Claim 17, Smith teaches displaying the relevant cost

(*displaying the total cost of said media request on said display device of said media*

selection interface); checking and accepting any payment made (*prompting said user to*

make a payment for said media request; and verifying payment of said payment for said

media request before); printing the indicated at least one news item; and delivering the

at least one printed news item to a customer (Col. 1, lines 57-60 (*communicating said media request to said service provider*).

In regard to dependent Claim 18, Claim 18 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 9, and is rejected along the same rationale.

In regard to dependent Claim 19, Smith teaches that the newspaper can be purchased by either inserting a banking or credit card in a card reader (52) or inserting coins into a coin slot (50). The vending machine (2) would then print out the up to the minute news requested (see Abstract; compare with Claim 19, **"... debiting a user's account for the cost of said media request following said printing of said hardcopy of said media request"**).

Claims 7-8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Leeke and in further view of Nozue et al. (hereinafter Nozue, U.S. Patent No. 5,845,262).

In regard to dependent Claims 7 and 8, Smith fails to specifically teach *at least one content provider in communication with said service provider for providing media in said data format to said service provider in response to said retrieved information* and *said at least one content provider comprises a media publisher computer for storing and transmitting said media in said data format to said service provider.* However, Nozue teaches that the producing system (1) is constructed by a publisher (10) and an electronic press information producer (20). Further, the publisher (10) is divided into a

newspaper company (11) (*content provider*), a publishing company (13) (*service provider*), and a small-scale publishing company (15) (*service provider*) (Col. 5, lines 45-49; Fig. 1) and Claim 8, *"... said at least one content provider comprises a media publisher computer for storing and transmitting said media in said data format to said service provider"*). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith, Leeke, and Nozue because all three inventions deal with customizing information content for purchase. Nozue adds the benefit of a network of information providers and producers to provide the content for selection and purchase.

In regard to dependent Claim 16, Smith's teachings are limited to newspaper distribution via vending machine. However, Nozue teaches a system for mainly transferring various information of a newspaper, a magazine, an advertisement, and the like by dot data. Data information provided from a newspaper company, publishing companies, and the like is converted into electronic press information via an electronic press producer (20). The electronic press information is dispatched from a center to an information vending machine through a satellite line or a terrestrial line (see Abstract) (*retrieving a list of newspapers and magazines available to said media selection interface from said service provider*). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Nozue as both inventions deal with providing a variety of information from newspapers, magazines and other sources over a network. Nozue adds the benefit of expanding the notion of the vending machine to a home user.

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Smith in view of Leeke and in further view of Miyasaka et al. (hereinafter Miyasaka, U.S.

Patent No. 6,766,362).

In regard to dependent Claim 20, Smith fails to teach *querying said determined*

content provider for said electronic copy of media associated with said media request;

including said set of user preferences with said query; and creating a customized

electronic copy of media associated with said media request based upon said set of

user preferences. However, Miyasaka teaches that a computer network server provides

a customized newspaper to a recipient according to recipient profile preferences. The

server searches for and obtains article content that is deemed to be of greatest interest

to the recipient according to topical preferences, generates a representation of the

selected content according to a layout preference, and delivers the representation to the

recipient according to a designated schedule. Recipient preferences are received and

stored in a profile database using facilities that assist a recipient to specify preferred

topics, newspaper layout, delivery schedule and destination. Topical designations are

mapped into hierarchical structures that facilitate searching content databases.

Newspaper articles are arranged according to relative priorities of designated topics

(see Abstract). It would have been obvious to one of ordinary skill in the art at the time

of invention to combine the teachings of Smith and Miyasaka because both deal with

obtaining customized news content. Miyasaka provides the benefit of using a provided

user profile in the search, retrieval, and construction of content for the user.

In regard to dependent Claim 21, Smith fails to teach *displaying a user log-in request on said display device of said media selection interface; prompting said user to enter log-in information using said input device of said media selection interface; communicating said log-in information to said service provider using said at least one communications port; comparing said log-in information to at least one user profile database accessible to said service provider to determine an identity of said user; authorizing use of the media selection interface when said identity of said user is determined; and prompting said user to register a user profile in said user profile database if said identity of said user is not determined and authorizing use of the media selection interface following completion of said registration of said user profile.*

However, Miyasaka teaches a news server (5) requires an individual to setup a subscription by registering individual information in profile database (42). The form shown in Fig. 5A is one example that allows an individual to register for a new subscription (*displaying a user log-in request on said display device of said media selection interface* and *prompting said user to enter log-in information using said input device of said media selection interface*), or to review and modify current preferences for an existing subscription (Col. 4, lines 33-37). Forms are presented on the screen of display device (26) that guide and assist an individual in using input device (24) to enter and submit information (*communicating said log-in information to said service provider using said at least one communications port*). Miyasaka also teaches that individuals having an existing subscription may review current preferences by entering a "user id" and an associated "password" in the spaces provided and then "clicking" on the "Go"

button with a pointing device such as a mouse. In response, news server (5) returns a

form such as that shown in Fig. 5G, which gives a registered individual an opportunity to

review and modify current preferences (*comparing said log-in information to at least one*

user profile database accessible to said service provider to determine an identity of said

user and *authorizing use of the media selection interface when said identity of said user*

is determined) (Col. 4, liens 49-55). Miyasaka also teaches that individuals who wish

to register for a new subscription may indicate this by clicking on the "Start" button. In

response, news server (5) returns one or more forms that allow the individual to enter

personal preferences. Examples are shown in Figs. 5B to 5G (*prompting said user to*

register a user profile in said user profile database if said identity of said user is not

determined and authorizing use of the media selection interface following completion of

said registration of said user profile) (Col. 4, lines 57-61). It would have been obvious to

one of ordinary skill in the art at the time of invention to combine the teachings of Smith

and Miyasaka because both deal with subscribing to online systems using preferences

to obtain personalized news materials. Miyasaka adds the benefit of an explicit user

interface to ensure that an individual and their preferences and profile are recognized.

In regard to dependent Claims 22 and 23, Claims 22 and 23 reflect the method of

creating a hardcopy media selection made by a user as claimed in Claim 21, and is

rejected along the same rationale.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
12/10/04

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER